IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	) Date: August 9, 2004
Edward P. Daniels, et al.	) Attorney Docket No.: F-373
Serial No.: 10/026,580	) Customer No.: 00919
Filed: December 19, 2001	) Group Art Unit: 3653
Confirmation No.: 9525	) Examiner: Jeffrey A. Shapiro

Title: METHOD OF ADDRESSING AND SORTING AN INTEROFFICE DISTRIBUTION USING AN INCOMING MAIL SORTING APPARATUS

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on July 1, 2004.

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Respectfully submitted,

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August 9, 2004
Date

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BOARD OF PATENT APPEALS AND INTERFERENCES

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APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claim 13 of the above-identified application mailed January 23, 2004. The fee for submitting this Brief is $330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of $330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**. Enclosed with this original are two copies of this brief.

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REAL PARTY IN INTEREST

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

The instant application was filed with claims 1-11. In the Amendment dated January 6, 2004, claims 1, 2 and 8 were amended.

STATUS OF AMENDMENTS

The are no pending amendment to the claims filed subsequent to the final rejection dated April 1, 2004. Therefore, the claims as set forth in Appendix A to this brief are those as set after the final rejection.

SUMMARY OF INVENTION

The processing and handling of mailpieces consumes an enormous amount of human and financial resources, particularly if the processing of the mailpieces is done manually. When it comes to the processing and handling of internal mailpieces, it is no different.

Regarding internal mailpieces, and like outgoing mailpieces, it needs to be addressed, collected and sorted efficiently to ensure that it gets to the addressee in a minimal amount of time. It is critical in nature relative to the success of a business that the processing and handling of the internal mailpieces be done efficiently and reliably so as not to negatively impact the functioning of the business.

The present claimed invention achieves this need of improving the efficiency and reliability of internal mail distribution by centralizing the gathering, addressing and sorting of internal mailpieces. More specifically, the present claimed invention provides a solution where the capability of addressing and sorting internal mailpieces is integrated within an incoming mail sorting apparatus. The foregoing is accomplished by providing a method of using an incoming mail sorting apparatus which includes the steps of :

> a) printing employee address information on an unaddressed employee mailpiece using a printer situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus; and
>
> b) delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus.

Hence, both the addressing and sorting of employee mailpieces are performed in an "incoming mail sorting apparatus."

ISSUES

The issues on appeal are:

A) Whether claims 1-11 are rendered obvious under 35 USC §103 in view of U.S. Patent No. 6,156,988 to Baker (the Baker patent);

B) Whether claims 1-11 are rendered obvious under 35 USC §103 in view of U.S. Patent No. 5,703,783 to Allen et al. (the Allen patent) in view of U.S. Patent No. 6,003,902 to Petkovsek (the Petkovsek patent);

C) Whether claims 1-11 are rendered obvious under 35 USC §103 in view of U.S. Patent No. 4,800,506 to Axelrod et al. (the Axelrod patent); and

D) Whether claims 1-11 are rendered obvious under 35 USC §103 in view of U.S. Patent No. 4,832,504 to Tripathi et al. (the Tripathi patent).

GROUPING OF CLAIMS

Claims 1-11 are grouped together, thus they stand or fall together.

ARGUMENT

As Appellant discusses in detail below, the final rejection of claims 1-3 are devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Each independent claim (namely, 1, 2 and 8) recites that "unaddressed" mailpieces are processed in a incoming mailpiece sorting apparatus with the sorting apparatus then printing employee address information onto the unaddressed mailpiece

thus maturing the mailpiece to an addressed mailpiece. For instance, with reference to claim 2 (it is submitted claims 1 and 8 contain similar recitations), it is recited:

> . . . b) placing unaddressed employee mailpieces on the incoming mail sorting apparatus;
>
> . . .e) printing the employee information on the unaddressed employee mailpiece; and
>
> f) delivering the employee mailpiece to a destination bin designated by the destination bin information.

Thus, the present claimed invention is able to individually address each mailpiece in a generic mail distribution for intended employees wherein the mailpieces are initially presented to the sorter apparatus devoid of any employee addressing information, hence the aforesaid "unaddressed" designation in the claims. Once addressed, they are then each delivered to an appropriate sorting bin, which maximizes the efficiency for the ensuing internal mail distribution, thus significantly improving the efficiency of interoffice mail distribution.

In each of the above rejections, the Examiner asserts each cited reference teaches or suggests using "an incoming mail sorting apparatus" for "printing employee address information on an unaddressed employee mailpiece." This is simply not so. For at least the reasons set forth below, none of the cited references teach or suggest this. As will also be explained further below, only the Baker and Allen patents even teach of using a sorting apparatus, with each explicitly requiring that the disclosed sorting apparatus must be used in conjunction with an addressed mailpiece. The deficiencies of each cited reference (namely the Baker, Allen, Axelrod, Petkovsek and Tripathi patents) will now be explained with specific reference to each.

A. The Baker Patent

The examiner alleges the Baker patent teaches printing employee address information on mailpieces in an incoming sorting apparatus by making reference to its

Fig. 1. Fig. 1 of the Baker patent is a front view of a reusable envelope having blank address destination spaces (9). However, the Baker patent specifically teaches that these blank address destination slots (9) must be filled in prior to the reusable envelope being submitted for processing in the sorting apparatus. In its own recitations, the Baker patent states:

> When a user of the system wishes to direct materials to another person within their organization, she selects an unused destination slot 9, writes the recipient's name in a recipient entry space 5, and writes the recipient's mail stop one character per block in the corresponding mail stop entry space 7. (Col. 2, lines 56-61) . . .
>
> . . . Envelope 1b is then transported to destination imager 29. Destination imager 29 scans envelope 1b based on the information received from carrier information database 27 to determine in which destination slot 9 the sender has written the current recipient's name and mail stop. (Col. 4, lines 4-8).

Thus it can be said that the Baker patent actually teaches away from using a sorting apparatus for "printing the employee information on the unaddressed employee mailpiece" as it requires the employee addressing information must be printed on the mailpiece before being placed onto a sorter. Construing the sorting apparatus disclosed in the Baker patent to be able to print employee information on an unaddressed mailpiece would indeed render it inoperable as the sorting apparatus as taught by the Baker patent has no teachings nor suggestions for processing, and then printing, addressing information on unaddressed mailpieces. In other words, presenting a reusable envelope having only blank address destination spaces (9) with none filled in to the Baker sorting apparatus would clearly cause an inoperable condition.

Accordingly, and for at least the above stated reasons, independent claims 1, 2 and 8, along with their respective depending claims (namely 3-7 and 9-11) patentably distinguish from the Baker patent. It is respectfully submitted that withdrawal of the rejection of claims 1-11 under 35 USC 103 in view of the Baker patent is warranted.

B. The Allen and Petkovsek Patents

The examiner alleges the Allen patent teaches printing employee address information on mailpieces in an incoming sorting apparatus by making reference to the barcode and labeler printers (94), (112), as well as addressee database (132), that are depicted in Fig. 9 of the Allen patent. A proper reading of the Allen patent reveals that it teaches of a sorting apparatus which is used by postal services for generating change of address labels. As is conventional and as one skilled in the art would expect, in order for a change address label to be generated there first must be a disfavored address printed on the mailpiece, which disfavored address is detected by the sorting apparatus (e.g., via OCR). And this is exactly what the Allen patent teaches. That is, upon the detection of a disfavored address on a mailpiece being processed in a postal service sorting apparatus, a query is made to a change-of-address database to determine a forwarding or correct address. After a favored (e.g., forwarding) address is determined, a mailing label is generated setting forth this favored address, which is then applied to the mailpiece having the disfavored address. In fact, regarding the detection of the aforesaid disfavored addresses, the Allen patent explicitly teaches:

> Machine readable mailpieces are processed by an automated optical scanning system commonly referred to as a Multiline Optical Character Reader (MLOCR) 66. Non-machine readable mailpieces are received either directly from FC 48 [facer canceller] (path 60) or indirectly from the MLOCR 66 (path 68) and processed by a semi-automated optical imaging apparatus commonly referred to as a Remote Bar Coding System (RBCS) 70. (Col 5, lines 39-46).

Thereforethe Allen patent (and like the aforesaid Baker patent) explicitly teaches that in order for its mailpiece sorting apparatus to operate each mailpiece must contain a printed address before it placed into the sorting apparatus (it is irrelevant if the printed address is a favored or disfavored one). Otherwise, "placing unaddressed mailpieces on the incoming mail sorting apparatus" as taught by the Allen patent would clearly produce an inoperative condition as the system taught by the Allen patent would have no way to determine a favored address for it. Thus the mailpiece

processing and sorting system of the Allen patent could never perform the step: "placing unaddressed employee mailpieces on the incoming mail sorting apparatus", or for that matter, "printing the employee information on the unaddressed employee mailpiece" since each mailpiece must be addressed before it is placed in the system taught by the Allen patent. For at least these reasons, the present invention as defined by independent claims 1, 2 and 8 patentably distinguish from the teachings of the Allen patent.

With regards to the Petkovsek patent, it is combined with the Allen patent because it allegedly teaches "generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces." Without going into to the merits of this alleged teaching, the Petkovsek clearly does not teach nor suggest "placing unaddressed employee mailpieces on the incoming mail sorting apparatus [and] . . . printing the employee information on the unaddressed employee mailpiece . . ." and thus does not overcome the above-mentioned deficiencies of the Allen patent.

Accordingly, and for at least the above stated reasons, independent claims 1, 2 and 8, along with their respective depending claims (namely 3-7 and 9-11) patentably distinguish from the combination of the Allen patent with the Petkovsek patent. It is respectfully submitted that withdrawal of the rejection of claims 1-11 under 35 USC 103 in view of the Allen and Petkovsek patents is warranted.

C. The Axelrod Patent

The examiner alleges the Axelrod patent teaches 1) "placing unaddressed mailpieces on the incoming mail sorting apparatus" (with reference to Figs. 2a-2d and 3 of the Axelrod patent), and 2) delivering the employee mailpiece to a destination bin designated by destination bin information stored in at least one database of the mail sorting apparatus" (with reference to col. 20, lines 34-41 of the Axelrod patent).

First, the instant claimed invention relates to "A method of using an incoming mail sorting apparatus." The commonly assigned Axelrod patent does not relate, teach,

suggest nor disclose anything relating to an incoming mail sorting apparatus. The Axelrod patent relates to an apparatus "for preparing mailpieces . . ." (See, Summary Of Invention). An apparatus for preparing mailpieces is quite different than an incoming mailpiece sorting apparatus. As is known to one skilled in the art, an apparatus for preparing mailpieces does just that . . . it generates mailpieces. On the other hand, an incoming mail sorting apparatus sorts mailpieces already prepared or generated.

With regards to "placing unaddressed mailpieces on the incoming mail sorting apparatus", there simply is no incoming mailpiece sorting apparatus taught or suggested by the Axelrod patent. Applicants being a leader in the mailpiece industry respectfully disagree with the examiner's assertion that a mailbag is analogous to an incoming mailpiece sorting apparatus, which difference one skilled in the art would readily appreciate. Likewise, Applicants respectfully disagree with the examiner's assertion that any illustration in figs. 2a-2d and 3 depicting "sending printed letters to a letter stuffing module" is in any way analogous to an "incoming mailpiece sorting apparatus", which difference again one skilled in the art would readily appreciate. Simply put, a sorting apparatus has a plurality of destination bins, with each bin typically being designated to contain mailpieces addressed to a common location. Surely, a "mailbag" or a "letter stuffing module" cannot be said to teach or suggest a sorting apparatus. For instance, one skilled in the art would expect that a mailpiece generating apparatus as taught by the Axelrod patent would disclose addressing mailpieces since its function is to generate mailpieces. However, one skilled in the art would not expect to be able to "plac[e] unaddressed employee mailpieces on the incoming sorting apparatus" since such sorting apparatus are designed (with the exception of the present invention) only to be compliant with previously addressed mailpieces due to its inherent sorting processing.

Regarding the examiner's assertion that the Axelrod patent teaches "delivering the employee mailpiece to a destination bin designated by destination bin information" (with reference to Column 20, lines 34-41 of the Axelrod patent), the Axelrod patent does not teach nor suggest delivering a mailpiece to a particular destination. This is simply because the Axelrod patent is not concerned with sorting individual mailpieces. What is meant by the teaching set forth in column 20, lines 34-41 of the Axelrod patent is that

mailpieces are generated as manifested groupings, which manifested grouping is disposed in a bulk mailpouch. Hence, after that manifested mailpiece grouping is generated, the mailpiece generating apparatus of the Axelrod patent then preferably produces another manifested mailpiece grouping, which is to be disposed in another bulk mailpouch. It is submitted one skilled in the art would readily recognize that sequentially depositing bulks of manifested mailpieces into mailpouches is not analogous to "delivering the employee mailpiece to a destination bin designated by destination bin information." There is simply no sorting performed in the mailpiece generating apparatus taught by the Axelrod patent.

Accordingly, and for at least the above stated reasons, independent claims 1, 2 and 8, along with their respective depending claims (namely 3-7 and 9-11) patentably distinguish from the Axelrod patent. It is respectfully submitted that withdrawal of the rejection of claims 1-11 under 35 USC 103 in view of the Axelrod patent is warranted.

D. <u>The Tripathi Patent</u>

With regards to the Tripathi patent, it teaches software product used to generate enhanced reports from a computer database or programming language. For instance, the Tripathi patent specifically teaches:

> . . . the automatic creation of a number of a number of different kinds of report enhancement by loading into the computer an enhanced report generator which will generate an enhanced report for any set of data, context and application. (See, Col. 1, lines 63-67).

Thus, the Tripathi patent teaches not of an incoming sorting apparatus, but rather of a software product that is loaded into a computer for generating enhanced reports. The examiner makes repeated reference to col. 5, lines 12-21 of the Tripathi patent, which merely teaches generating enhanced document destination reports by printing in a duplex or 4-up format and that "bar codes may be generated automatically from zip codes." It is respectfully submitted that in no way does this recitation of the Tripathi patent teach nor suggest processing unaddressed mailpieces in an incoming mailpiece sorting apparatus. For instance, it is devoid of any teaching relating to "placing

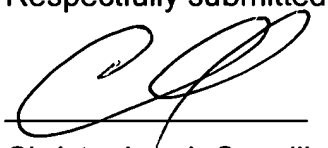
unaddressed employee mailpieces on the incoming mail sorting apparatus" as the mere generation of enhanced mailing reports surely cannot be said to teach this. Likewise, the generation of enhanced mailing reports cannot be said to teach or suggest "singulating an unaddressed employee mailpiece . . . [or] printing the employee information on the unaddressed employee mailpiece."

Accordingly, and for at least the above stated reasons, independent claims 1, 2 and 8, along with their respective depending claims (namely 3-7 and 9-11) patentably distinguish from the Tripathi patent. It is respectfully submitted that withdrawal of the rejection of claims 1-11 under 35 USC 103 in view of the Tripathi patent is warranted.

CONCLUSION

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-11 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

1. A method of using an incoming mail sorting apparatus to sort employee mailings, method comprising the steps of:

b) printing employee address information on an unaddressed employee mailpiece using a printer situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus;

b) delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus.

2. A method of using an incoming mail sorting apparatus to sort employee mailings, method comprising the steps of:

a) obtaining a group of unaddressed employee mailpieces;

b) placing unaddressed employee mailpieces on the incoming mail sorting apparatus;

c) singulating an unaddressed employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus;

d) obtaining employee address information and destination bin information from at least one database of addressee information;

e) printing the employee information on the unaddressed employee mailpiece; and

f) delivering the employee mailpiece to a destination bin designated by the destination bin information.

3 The method as claimed in claim 2 further comprising the step of:

g) repeating steps a) through f) until all employee mailpieces in the group of employee mailpieces have been delivered.

4. The method as claimed in claim 3 further comprising the step of:

h) generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces.

5. The method as claimed in claim 2 wherein in step e) the employee information includes employee name and delivery code information.

6. The method as claimed in claim 2 wherein in step e) the employee information includes a message to the employee.

7. The method as claimed in claim 2 wherein in step e) the employee information includes a clip art figure.

8. A method of using an incoming mail sorting apparatus to sort employee mailings, method comprising the steps of:

a) obtaining a group of unaddressed employee mailpieces;

b) placing unaddressed employee mailpieces on the incoming mail sorting apparatus;

c) singulating an unaddressed employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus;

d) obtaining employee address information and destination bin information from at least one database of addressee information; and

e) printing the employee address information on the unaddressed employee mailpiece;

f) delivering the employee mailpiece to a destination bin designated by the destination bin information;

g) repeating steps a) through f) until all employee mailpieces in the group of employee mailpieces have been delivered; and

h) generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces.

9. The method as claimed in claim 8 wherein in step e) the employee information includes employee name and delivery code information.

10 The method as claimed in claim 8 wherein in step e) the employee information includes a message to the employee.

11 The method as claimed in claim 8 wherein in step e) the employee information includes a clip art figure.